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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/024,098 | 12/18/2001 | David A. Witt | END-805 | 5974 |

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EXAMINER

THALER, MICHAEL H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3731

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/024,098

Applicant(s)
Witt et al.

Examiner
Michael Thaler

Art Unit
3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other: _____

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Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 5, there is no antecedent basis for "said clamp arm".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Davison et al (5,322,055). Davison et al., in figures 1-3, show housing 22, ultrasonic waveguide 16, end-effector 18, 20, actuator 26, clamp means 24 and actuator 52.

Claims 1-6, 9-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (5,873,873) in view of Tovey et al. (5,489,292). Smith et al. show housing 160,

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ultrasonic waveguide 180 having end effector 180', clamp arm 190 and actuating element 170. Smith et al. fail to show at least one hole in the clamp arm. However, Tovey et al., in col. 13, lines 53-67 and figures 20-23, teach that a clamp arm 232 (figure 23) for a surgical instrument should have at least one hole 238 therein in order to enhance its gripping ability. Including such holes in the Smith et al. clamp arm 190 so that it too would have this advantage would have been obvious. The Smith et al. clamp arm 190, when so modified, would have a top surface (the surface facing away from end effector 180') and bottom surface (the surface facing towards end effector 180') comprising at least one engaging surface (the surface of pad 192 which would surround each hole and which engages tissue). As to claim 2, Tovey et al. show a slot (between ribs 222) extending from the proximal end (portion) of the clamp arm distally into the clamp arm. This slot would be incorporated into the Smith et al. clamp arm 190. As to claim 3, Smith et al. fail to show the distal portion of the clamp arm as being curved. However, it is well known in this art to include a proximal straight section and a distal curved section in surgical jaws or clamp arms in order to reach certain tissues. It would have been obvious to so shape the Smith et al. clamp arm so that it too would have this advantage. As to claim 4, the Smith et al. clamp arm 190, when modified as set forth above, would have a plurality of

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engaging surfaces (the surfaces of pad 192 which would surround the holes and which engages tissue).

Claims 7, 12, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (5,873,873) in view of Howell et al. (6,099,539) and Fogarty et al. (3,503,398). Smith et al. fail to show at least one hole in the clamp arm 190. However, Howell et al. teach that a clamp arm (31 or 32) for a surgical instrument should have at least one hole 31 therein in order to increase the cushioning effect of the clamp arm on tissue (col. 2, lines 43-65 and col. 6, lines 41-44). Including such holes in the Smith et al. clamp arm 190 so that it too would have this advantage would have been obvious. The Smith et al. clamp arm 190, when so modified, would have a top surface (one of the side surfaces which would be at the top when the instrument is appropriately oriented) and bottom surface (the opposite side surface which would be at the bottom when the instrument is appropriately oriented) comprising at least one engaging surface (the portion of the side surface of pad 192 which would surround each hole and which is capable of engaging tissue when the clamp arm is inserted within tissue). Smith et al. fail to show a T-shaped slot in the clamp arm. However, Fogarty et al. teach that a clamp arm should include a T-shaped slot (e.g. 25, 26) in order to receive a corresponding shaped portion (e.g. 35, 36) of a pad for the clamp arm, in order to removably and yet positively secure the pad onto the clamp arm. Including such a T-

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shaped slot in the Smith et al. clamp arm 190 in order to removably and yet positively secure the pad 192 thereon would have been obvious for this reason.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
April 11, 2003



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731